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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/709,649	02/22/2007	Dale Menendez	9164/99159	3436

24628 7590 01/31/2017  
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EXAMINER
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GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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01/31/2017

PAPER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DALE MENENDEZ

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Appeal 2015-002835<sup>1</sup>  
Application 11/709,649  
Technology Center 3600

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Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and  
MICHAEL W. KIM, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 57–75 and 77. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to the payment of claims on insurable losses. Spec. ¶ 1.

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<sup>1</sup> The Appellant identify the Inventor, Dale Menendez, as the real party in interest. Appeal Br. 2.

Claim 57 is illustrative:

57. A method of expediting, automatically processing and resolving an insurance claim submitted under one of a plurality of different policy types of insurance, such method comprising the steps of:

- providing in a memory of a processor apparatus plural sets of keywords, wherein each set of keywords is associated with at least one of the plurality of policy types and wherein the keywords in each set of said plural sets of keywords are descriptive of insurance requirements, terms, conditions, exclusions, limitations and damages associated with a respective policy type of the plurality of policy types;

- receiving and saving in the memory via a processor apparatus a claim reported from an insured, their agent, broker or others through at least an Internet connection wherein the received claim contains a description of how the loss occurred, where the description is used for determining a who, what and why about how the loss occurred;

- determining via a processor apparatus a policy type of the plurality of policy types from said received claim;

- identifying via a processor apparatus an insurance criteria for evaluating the claim from said determined policy type, wherein the insurance criteria is based upon the insurance criteria of the determined policy type, insuring agreements, exclusions, coverage limits, terms, conditions and limitations selected from the group of different insurance criteria consisting of all risk of loss, named perils, accident to object, supplemental coverage, consequential loss, coverage extensions, endorsements, exclusions, limitations, property covered and not covered or limited;

- retrieving from said memory via a processor apparatus a set of keywords of the plurality of keywords, said retrieved keywords being associated with said determined policy type and with said identified insurance criteria;

- matching via a processor apparatus said retrieved set of keywords with words contained within the claim and the description of how the loss occurred of said received claim;

assigning via a processor apparatus the claim to an adjuster when any matched or unmatched word or words of said matching step meets a predetermined criteria; and

paying via a processor apparatus the claim without assigning the claim to an adjuster when said matching step does not meet the predetermined criteria and any auxiliary criteria.

Claims 57–75 and 77 are rejected under 35 U.S.C. § 101 as reciting ineligible subject matter in the form of an abstract idea.

Claim 77 is rejected under 35 U.S.C. § 101 as reciting ineligible subject matter that encompasses signals.

Claims 57–75 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 57–74 and 77 are rejected under 35 U.S.C. § 103(a) as unpatentable over Aquila (US 2002/0035488 A1, pub. Mar. 21, 2002) and McCormack (US 6,049,773, iss. Apr. 11, 2000).

Claim 75 is rejected under 35 U.S.C. § 103(a) as unpatentable over Aquila, McCormack, and Hall (US 7,085,735, iss. Aug. 1, 2006).

We AFFIRM.

## ANALYSIS

### Rejection of Claims 57–75 and 77 under 35 U.S.C. § 101

We are not persuaded by the Appellant’s argument that the claims are not an abstract idea, because they “are directed to a very precise set of steps set in the context of structure for executing those steps.” Reply Br. 2.

Based primarily on the wording of the claims as a whole, the Examiner finds that the claims are directed to the abstract idea of processing an insurance claim, including identifying a policy type from words in the

claim, and making a decision whether to pay the claim or assign the claim to an adjuster, which amounts to both a fundamental economic practice, and/or a method of organizing human activities. Answer 23–24. The Examiner also finds all additional claimed elements merely represent instructions to implement the abstract idea on a general-purpose computer. Answer 24.

The Appellant has not persuasively demonstrated error in the Examiner’s rejection. The following constitutes the entirety of the Appellant’s assertions concerning this rejection: “A simple review of the claims reveals that the claims are directed to a very precise set of steps set in the context of structure for executing those steps.” Reply Br. 2. As an initial matter, we are unclear how any amount of “precision” in the method steps, convert an otherwise ineligible abstract idea into eligible subject matter. Moreover, even if “precision” could generally be shown to cause such conversion, here, the Appellant has not provided any analysis as to how any particular “precise” limitation or limitations would facilitate such a conversion. Indeed, the Appellant does not identify any limitations at all.

For these reasons, we sustain the rejection of claims 57–75 and 77 under 35 U.S.C. § 101 as reciting an ineligible abstract idea.

*Rejection of Claim 77 under 35 U.S.C. § 101*

We are not persuaded by the Appellant’s argument that the memory in claim 77 “is not directed to transient signals” (Appeal Br. 8–9), and the claimed memory “by definition” is non-transient (Reply Br. 2). The claim does not limit the memory to exclude a transient storage medium, and the Specification does not define or limit memory to be limited to any particular technology, or to exclude transient signals as a storage medium. In spite of

the Appellant's assertion that transient signals were not claimed, the broadest reasonable interpretation of the claim language encompasses memory in the form of transient signals, which is not eligible subject matter. *In re Nuijten*, 500 F.3d 1346, 1355 (Fed. Cir. 2007).

The USPTO also provides the following guidance:

The broadest reasonable interpretation of a claim drawn to a computer readable medium . . . typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. . . . When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

*Rejection of claims under 35 U.S.C. § 112, Second Paragraph*

We agree with the Appellant that the “determined policy type” language of claim 57 is clear on its face. Appeal Br. 9. The Examiner asserts that the phrase “from said determined policy type” in the identifying step of claim 57 is unclear because, according to the Examiner, it is not clear if the words “are intended to modify the term ‘identifying’” or the term “claim.” Answer 3–4.

The claim language of the “determining” step clearly indicates that a “policy type” is determined from a received claim, and the “identifying” step clearly indicates that “insurance criteria” are identified based on the “determined policy type.” Thus, the phrase “from said determined policy type” does not modify either the “identifying” or the “claim,” because it merely indicates from what source particular information is determined.

We also agree with the Appellant that the “selected from the group” language of claim 57 is clear on its face. Appeal Br. 9. According to the Examiner, it is not clear what the words “selected from the group” refers to. Answer 4–5. The language at issue is as follows:

the insurance criteria is based upon the insurance criteria of the determined policy type, insuring agreements, exclusions, coverage limits, terms, conditions and limitations selected from the group of different insurance criteria consisting of all risk of loss, named perils, accident to object, supplemental coverage, consequential loss, coverage extensions, endorsements, exclusions, limitations, property covered and not covered or limited.

The plain meaning of the aforementioned language is that insurance criteria are based on, at a minimum, six information types, labeled 1) insurance criteria of the determined policy type, 2) insuring agreements, 3) exclusions, 4) coverage limits, 5) terms, and 6) conditions. The claim also includes, however, optionally selected “limitations” from additionally-recited information types labeled as “different insurance criteria consisting of all risk of loss, named perils, accident to object, supplemental coverage, consequential loss, coverage extensions, endorsements, exclusions, limitations, property covered and not covered or limited.”

Because the language of claim 57 is clear, we do not sustain the rejection of claims 57–75 as indefinite under 35 U.S.C. § 112, second paragraph.

*Rejection of Claims 57–74 and 77 under 35 U.S.C. § 103(a)*

We are not persuaded by the Appellant’s argument that, according to the Appellant, Aquila does not match keywords, as claimed, because instead

Aquila uses answers from questions to generate a score. Appeal Br. 10; *see also* Reply Br. 3–4.

The Examiner finds Aquila discloses providing keywords from “policy profile information” and other sources. Answer 6–9, (*citing* Aquila Figures 1 and 19, and paragraphs 20, 38, 53, 83, 138–41, 155, 162, 213, and 218); *see also* Answer 27 (*citing* Aquila paragraphs 142, 172–211, 214, and 215). The Examiner finds Aquila discloses that words are matched with keywords to generate a score. Answer 10–11 (*citing* Aquila paragraphs 160–62, 184, 205, 213, 214, and Figure 6). Aquila, thus, uses words from questions, matched against keywords from a database containing at least “policy profile information,” to generate a score. The Appellant asserts that Aquila does not disclose using keywords for matching, but has not shown error in any findings the Examiner has made related to providing keywords and matching keywords.

The Appellant argues Aquila teaches away, because “Aquila discourages the claimed invention because it instead pays on a score rather than upon any matching of keywords.” Reply Br. 4. We disagree with the Appellant. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citations and internal quotation marks omitted). Because Aquila uses keywords for matching, in order to generate a score, as we advanced above, Aquila does not discourage the use of keywords. In addition, the Appellant does not provide any citation to



indicate where Aquila discourages the use of keywords, and, thus, have not persuasively shown error in the Examiner's use of Aquila.

We are finally unpersuaded by the Appellant's argument that McCormack does not disclose using keywords to pay a claim, because McCormack is directed to reinsurance. Appeal Br. 10. The Examiner finds Aquila discloses the use of keywords in automatically paying a claim, as claimed, but does not explicitly disclose the word "keyword," which the Examiner finds in McCormack. Answer 12. The Examiner did not rely on McCormack as disclosing the claim language about paying a claim, which is disclosed in Aquila, but only for the explicit use of the term "keyword." A reference does not have to satisfy an *ipsissimis verbis* test to disclose a claimed element. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). So the fact that McCormack may or may be directed to reinsurance is irrelevant to the Examiner's reliance on McCormack for the narrow disclosure "keyword" in a general insurance context. Furthermore, we note that, in any case, Aquila discloses keywords, as claimed, so the disclosure of McCormack is cumulative.

We are not persuaded by the Appellant's argument that the combination of Aquila and McCormack does not disclose the claim language because "Aquila is merely directed to assigning claims to agents and McCormack et al. to reinsurance." Appeal Br. 13. The Appellant here is making a sweeping allegation that Aquila does not disclose the claim language, as the Examiner specifically finds and articulates at pages 6–12 of the Answer (and pages 6–12 of the Final Action), because Aquila assigns claims to agents. The Examiner, however, has clearly shown that Aquila discloses far more than merely assigning claims to agents, and the Appellant

has not advanced arguments of error specific to the findings on the record. A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

We are not persuaded by the Appellant's argument that the combination of Aquila and McCormack does not "recognize the problem solved by the claimed invention," and that, therefore, there would be no reason to combine the references. Appeal Br. 13. It is not necessary for the prior art to serve the same purpose as that disclosed in the Appellant's Specification in order to support the conclusion that the claimed subject matter would have been obvious. *See In re Linter*, 458 F.2d 1013, 1016. All that is required is for the Examiner to provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.* 550 U.S. 398, 418 (2007). To that end, the Appellant has not persuasively shown why the Examiner's proffered reasons to combine, even if different from the Appellant's, are legally deficient.

For these reasons, we sustain the rejection of claims 57–74 and 77 under 35 U.S.C. § 103(a).

*Rejection of Claim 75 under 35 U.S.C. § 103(a)*

The Appellant's do not advance argument specific to the separate rejection of claim 75. We, therefore, sustain the rejection of claim 75 for the same reasons given above.

DECISION

We AFFIRM the rejections of claims 57–75 and 77 under 35 U.S.C. § 101.

We REVERSE the rejection of claims 57–75 under 35 U.S.C. § 112, second paragraph as indefinite.

We AFFIRM the rejections of claims 57–75 and 77 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED